

REMARKS

With this Response, claims 1, 11, 23 and 30 are amended. No claims are added. No claims are cancelled. Therefore, claims 1-3, 5-14, 16-21 and 23-32 are pending.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 1-3, 5-21 and 23-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,437,052 to Iwasa et al. (hereinafter “Iwasa”) and European Patent No. EP1126322 to Harada et al. (hereinafter “Harada”).

Claims 1, 11, 30

The Office Action states,

Harada et al disclose a polymer for a photoresist comprising (meth)acrylic monomers which may comprise a diol as instantly claimed (specifically see 95) on page 6 wherein R5-R7 may be a cyclic alkyl group).

Applicant respectfully submits Harada fails to disclose the recited “cycloolefin functionalized with a di-ol.” Applicant first notes Harada structures (4) through (32) are predominantly concerned with ester functional groups (O=C-OR). Specifically, in (5) the two hydroxyl groups are part of an alkyl bonded to an oxygen atom to form an ester functional group. Second, while R5-R7 in (5) may indeed be cyclic groups, Applicant submits one of ordinary skill in the art would not understand those cyclic groups to be “functionalized with a di-ol” because R5-R7 do not have a functional group including a di-ol. Rather, R5-R7 of (5) are merely part of the same monomer as the ester, which is not all that was claimed by Applicant.

Nonetheless, in an effort to advance prosecution, Applicant has amended claim 1 to further recite, “cycloolefin functionalized with a di-ol, wherein the di-ol comprises an alkyl bonded to the cycloolefin.” This amended language is supported by Figure 1 and paragraph 20. This claimed structure is in clear contrast with Harada’s ester functional group because Harada’s alkyl including the hydroxyl groups is bonded to an oxygen atom, not a cycloolefin as claimed in the present application.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 1, and all dependents thereof, is requested.

Claims 11 and 30 have been amended in a manner substantially equivalent to that described for claim 1 and therefore, for a similar reason, favorable reconsideration and

withdrawal of the rejection of independent claims 11 and 30, and all dependents thereof, is requested.

Claim 10

MPEP § 2142 mandates:

The Examiner bears the initial burden of **factually** supporting the *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness. (emphasis added)

Applicant respectfully submits the Office Action has failed to factually support a *prima facie* conclusion of obviousness of claim 10 because Harada fails to disclose the recited structure wherein the cycloolefin is bonded to the alkyl group including the di-ol. Throughout prosecution the specific structure of claim 10 has been rejected with no basis beyond that provided for the independent base claim. Applicant does not understand how the specificity of claim 10 fails to warrant further specificity from the Office. Specifically, for the most recent Office Action, Applicant requests an explanation of how Harada's ester provides a basis for rejecting the structure of claim 10 as obvious.

Accordingly, in the event that the Office maintains a rejection of claim 10, Applicant respectfully requests, in the interests of compact prosecution, that the Office apply art against each feature of claim 10, on the record, and with specificity sufficient to support a *prima facie* case of anticipation or obviousness.

The absence of additional patentability arguments should not be construed as either a disclaimer of such arguments or that such arguments are not believed to be meritorious.

CONCLUSION

Applicant respectfully requests examination of the above-identified application in view of the response.

For at least the foregoing reasons, Applicant submits that the rejections of the claims have been overcome herein, placing all pending claims in condition for allowance. Such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-identified application.

The Commissioner is authorized to charge or credit any deficiencies or overpayments in connection with this submission to Deposit Account No. 02-2666, and is requested to notify us of same.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

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/James M. Howard/
James M. Howard
Reg. No. 56,377

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
Telephone: (503) 439-8778